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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,407	12/05/2003	David Wadlow	3020	9757
7590	04/22/2005		EXAMINER	
Walter A. Hackler Suite B 2372 S.E. Bristol Newport Beach, CA 92660			MULLEN, THOMAS J	
			ART UNIT	PAPER NUMBER
			2632	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,407

Applicant(s)

WADLOW ET AL.

Examiner

Thomas J. Mullen, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment filed 12/20/04 has been fully considered. Although the various changes to the specification, claims and abstract were entered, it should be noted that certain changes to the specification and abstract were made without the proper underlining and/or strikethrough required by 37 CFR 1.121 (e.g., changes in the paragraph beginning at page 1, line 2, and changing the last occurrence of "said" to --the-- in the abstract), and for many claims the improper status identifier "Previously Amended" was used (should be "Previously Presented"). Also, in claim 11, line 2 the use of the pairs of double slashes, which occur both before and after an inserted period (which is underlined), does not appear to be in accordance with 37 CFR 1.121.

2. The disclosure remains objected to because of the following informalities:

in the replacement abstract, fifth line from bottom, it appears that "oscillation" should be --oscillator-- (as noted in first Office action);

in the paragraph which was added after the last line of page 17 (in the preliminary amendment), where the term " ω_n " is defined at the end of the paragraph, there appears to be a formula or equation intended at that point but no such formula or equation is present (as noted in first Office action);

in the replacement paragraph (in the preliminary amendment) beginning at page 20, line 21 of the specification, at line 24 of the replacement paragraph, where "preset" was deleted it appears that the comma following "preset" should likewise be deleted (as noted in first Office action); and,

at page 28, line 30, "by" should be --be-- (as noted in first Office action).

Appropriate correction is required.

3. Claims 16-24 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, line 13, the slash ("/") inserted between "frequency" and "comparator" should instead be inserted between "phase" and "frequency"--i.e., "phase/frequency comparator".

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,731,209. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the sets of claims appears to be the broadening of "sense electrodes" and "at least two sense electrodes" to --a sense electrode-- and --at least one sense electrode--, respectively; one skilled in the art of capacitive proximity sensors would have recognized that single electrode sensors and multiple electrode sensors represent readily available and useful alternatives in the art, and thus either type would have been obvious to those skilled in the art based on the other type.

6. Applicant's arguments with respect to claims 1-24 (regarding the 112(1) rejection previously set forth, and hereby withdrawn) have been considered as follows: while several of applicant's points are not agreed with--e.g., an occurrence of the singular term "sensor" in the specification does not imply a device having only a single "electrode", since applicant is clearly using the term "sensor" to refer to a device having electrode(s) as opposed to a device being an electrode (i.e. the terms "sensor" and "electrode" do not have one-to-one correspondence in the disclosure), and thus a reference in the specification to a single "sensor" does not in itself provide support for a single-electrode embodiment--it is agreed that one skilled in the art, viewing applicant's original disclosure and having knowledge of prior art single electrode sensors (such

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as the "parallel plate" sensor discussed in the specification at page 3, lines 18-27) as well as knowledge of prior art multiple electrode sensors, would have found adequate written description and enablement in the original disclosure to carry out or implement one or more embodiments of applicant's invention using only a single electrode. However, upon further consideration of the relative scope or breadth of the recitations "a sense electrode" and "at least one sense electrode", the new ground(s) of rejection set forth herein are considered appropriate.

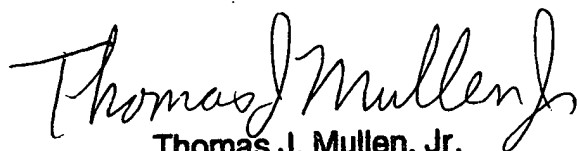
7. This Office action is non-final.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 571-272-2965. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

TJM



Thomas J. Mullen, Jr.
Primary Examiner
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